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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,207	11/03/2003	David B. Skursha	3206	4179

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THE LUBRIZOL CORPORATION
Patent Administrator - Mail Drop 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/700,207	Applicant(s) SKURSHA ET AL.	
	Examiner Michael P Nghiem	Art Unit 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6-10 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-3-03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I, Figs. 1-4, in the reply filed on November 4, 2004 is acknowledged. The traversal is on the ground(s) that all the claims are directed to the on-line monitoring and analysis of a fluid by data or temperature. Therefore, a relationship exists between all the groups of claims. This is not found persuasive because Species I-XII are distinct from each other. For example, Species I, Figs. 1-4, is directed to an invention for determining data-temperature dependence when fluid temperature increases whereas Species II, Figs. 1-3 and 5, is directed to an invention for determining data-temperature dependence when fluid temperature decreases.

Furthermore, Claims 2-4 are directed to an invention that determines data temperature dependence when fluid temperature increases and decreases. This limitation is not described in Species I of Figs. 1-4. However, it is described by Fig. 6 of Species III.

Claim 6 recites that the data collection, temperature dependence determination and use of the determined data temperature-dependence is for at least on data series. This limitation is not described in Species I of Figs. 1-4. However, it is described in Fig. 10 of Species VII.

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Claim 7 recites that the data collection, temperature dependence determination and use of the determined data temperature-dependence occurs each time the temperature change criteria are met. This limitation is not described in Species I of Figs. 1-4. However, it is described in Fig. 13 of Species X.

Claims 8-10 recite outputting information when a data-temperature-dependence is determined. This limitation is not described in Species I of Figs. 1-4. However, it is described in Fig. 12 of Species IX.

Claims 13-18 recite determining if a data temperature-dependence is externally inputted. This limitation is not described in Species I of Figs. 1-4. However, it is described in Fig. 14 of Species XI.

The requirement is still deemed proper and is therefore made FINAL. Claims 2-4, 6-10, and 13-18 are withdrawn from further consideration

Specification

2. The disclosure is objected to because of the following informalities: The specification is required to be corrected to reflect the cancelled drawings: Figs. 5-15.

Appropriate correction is required.

Claim Objections

3. Claims 11 and 12 are objected to because of the following informalities:

- claim 11, how can a data temperature dependence be selected from a group of steps (e.g. replacing step) ?
- claim 12, the property should be selected from a group of properties. Thus, is, for example, "the determined data temperature dependence alone" a property feature?
- claim 12, "determine" (line 4) should be – determined --.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[□] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, 11, and 13-15 of copending Application No. 10/271,885 (Lvovich et al., US 2004/0075448). Although the conflicting claims are not identical, they are not patentably distinct from each other because Lvovich et al. anticipates the claimed invention:

“A method (claim 1, claim 11) to temperature compensate data of a fluid while in use that comprises:

collecting data (claim 1, claim 11) when fluid temperature changes from a first threshold temperature to at least a second threshold temperature at least at a threshold rate (claim 6, claim 15);

determining the temperature dependence of the collected data (claim 4, claim 13); and,

using the determined data-temperature-dependence for temperature compensating data of the fluid's condition (claim 5, claim 14);

determining at least one of the following selected from the group consisting of: threshold temperature, threshold rate or combinations thereof (claim 6, claim 15);

the determined data-temperature dependence is used for data temperature compensation selected from the group comprising replacing the current data temperature dependence (claim 6, claim 15).”

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lvovich et al. (US 2004/0075448).

Regarding claim 1, Lvovich et al. discloses a method (Fig. 2) to temperature compensate data of a fluid while in use (paragraph 0055, lines 14-16) that comprises:

- collecting data (claim 1, lines 8-11) when fluid temperature changes from a first threshold temperature to at least a second threshold temperature at least at a threshold rate (claim 6, lines 4-6);

- determining the temperature dependence of the collected data (claim 4, lines 2-3);

using the determined data-temperature-dependence for temperature compensating data of the fluid's condition (claim 5, lines 1-9).

Regarding claim 5, Lvovich et al. discloses determining at least one of the following selected from the group consisting of: threshold temperature, threshold rate or combinations thereof (claim 6, lines 4-6).

Regarding claim 11, Lvovich et al. discloses replacing the current data-temperature dependence (claim 6, lines 4-5).

Regarding claim 12, Lvovich et al. discloses a property of the determined data-temperature-dependence not being within at least one limit is selected from determined data-temperature dependence alone (paragraph 0105, lines 15-20).

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'Michael Nghiem', with a stylized flourish at the end.

MICHAEL NGHIEM
PRIMARY EXAMINER

Michael Nghiem

November 19, 2004